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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jeff Tanner.

Serial No. 76416091

Stephen A. Anderson of Anderson & Associates for Jeff Tanner.

Sonya B. Stephens, Trademark Examining Attorney, Law Office 108 (Andrew D. Lawrence, Managing Attorney).

Before Hairston, Drost, and Kuhlke, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On June 6, 2002, Jeff Tanner (applicant) applied to register the mark shown below on the Principal Register for "clothing, namely, t-shirts, sweatshirts, sports shirts, hats and shorts" in Class 25. Serial No. 76416091.



While somewhat difficult to see in the drawing, the mark consists of the word CLUTCH and underneath that word is the word GEAR in smaller letters and a design of a gear or cogwheel.¹ The application indicates that the mark was first used anywhere and first used in commerce on April 1, 2002.

The examining attorney refused to register the mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of a registration for the mark CLUTCH and design shown below for "clothing, namely, suits, jackets, skirts, pants, evening dresses, formal dresses, short coats, trench coats, over coats, rain coats, jogging pants, sweatpants, [and] jumpers" in Class 25.

CLUTCH
クラッチ

¹ Applicant (brief at 6) and the examining attorney (brief at 1) refer to applicant's "cogwheel" design. A "cogwheel" is "a gearwheel, esp. one having teeth of hardwood or metal inserted into slots." *Random House Dictionary of the English Language (unabridged)* (2d ed. 1987). We take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). Applicant also refers to "the image of the cogwheel or 'clutch gear.'" Brief at 9.

The registration (No. 2,622,663) issued September 24, 2002 and contains a statement that the Japanese characters in the mark are a transliteration of the word "Clutch."

In addition to the refusal under Section 2(d), the examining attorney refused to register applicant's mark without a disclaimer of the term "Gear" under the provision of Section 6(a) of the Trademark Act. 15 U.S.C. § 1056(a). The examining attorney has required a disclaimer of the term on the ground that the term is merely descriptive of applicant's goods. See 15 U.S.C. § 1052(e)(1).

After the examining attorney made the refusals final, this appeal followed.

Likelihood of Confusion

We first address the question of likelihood of confusion, which requires us to consider the evidence in relation to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods

and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin our analysis by considering the similarities and dissimilarities of applicant's and registrant's marks. When we consider the marks, we look to see whether the marks are similar in appearance, sound, connotation, and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1691-92 (Fed. Cir. 2005). When we compare the marks, it is obvious that the marks are not identical but they do have the identical word "Clutch" prominently featured in both marks. Registrant's mark is the word CLUTCH in simple block letters above Japanese characters that the registration indicates are the transliteration of the word "Clutch." In the registrant's mark, the only other feature is the design consisting of four Japanese characters. To the majority of prospective purchasers in the United States, it is likely that these characters would only be viewed as Japanese characters that they are unable to translate. To the extent that prospective purchasers can understand Japanese, both the registration and

applicant (Brief at 14) agree that the characters would be roughly transliterated as "clutch."²

Applicant's mark consists of the word CLUTCH in large letters above the word GEAR in smaller letters and the design of a gear. The word CLUTCH is prominently featured in applicant's mark. The word, "gear," in addition to being in much smaller letters, is integrated into the gear design. Indeed, it may be hard for some prospective purchasers to easily recognize the word "gear."

Furthermore, we add that "clutch" has no meaning in relation to clothes. The examining attorney has submitted dictionary definitions of "gear" that indicates that it means "clothing." See Attachments to Final Office Action; Applicant's Brief at 7 ("Indeed, a descriptive word (like "GEAR") can be combined with nondescriptive wording...").

The examining attorney has also submitted copies of registrations that show that the term is often disclaimed when it is used in registrations for clothing. In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987) (Third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive). Under

² Applicant asserts (brief at 14) that the transliteration would not be pronounced exactly the same as the English word "clutch."

these circumstances, the term "gear" would have less trademark significance.

We also note that applicant's mark contains a gear design, while registrant's mark also includes Japanese characters. The presence of these two designs does not significantly change the marks because applicant's gear design simply appears to be a play on the word "gear" which would ordinarily mean "clothing" when applied to applicant's goods. Even the presence of an entirely different design does not necessarily avoid a likelihood of confusion. Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products). We add that the design in registrant's mark is simply a type of transliteration of the word in the mark. To those who understand Japanese, it would add little to the mark. Repeating a mark in Chinese, Japanese, Arabic, Hebrew, or similar non-western letters or characters would not add a significantly different feature to the mark. To those who are not fluent in Japanese, these characters would add a Japanese flavor to the mark but it is likely simply to suggest that the registrant is also marketing its goods internationally.

The meaning of the marks CLUTCH and Japanese characters and CLUTCH GEAR and gear design could be similar to the extent that CLUTCH has no meaning in relation to clothing and both marks could simply refer to the clutch in a motor vehicle. Applicant's mark certainly suggests a motor vehicle's clutch and many would likely understand that registrant's mark also has a similar meaning. Finally, the commercial impressions of the marks, while not identical, would not be significantly different inasmuch as both marks consist of the arbitrary term "clutch." See In re Chatam International Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ("With respect to JOSE, the Board correctly observed that the term simply reinforces the impression that GASPAS is an individual's name. Thus, in accord with considerable case law, the JOSE term does not alter the commercial impression of the mark." The marks JOSE GASPAS GOLD and GASPAS'S ALE were determined to be similar).

When we compare marks, we also keep in mind that a "[s]ide by side comparison is not the test." Grandpa Pigeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973). Furthermore, "[h]uman memories... are not infallible." In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986),

quoting, Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970).

Another point we add is that there is no evidence that the term CLUTCH is a weak mark when used in association with clothing.³

It is simply not enough to list the similarities and differences between the marks in a likelihood of confusion analysis. Instead, we must compare the marks in their entirety. However, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). When we consider the

³ Applicant refers to Serial No. 78027374 for the mark CLUTCH GOLF as evidence that its mark is registrable. We note that this intent-to-use application is now abandoned. An abandoned, intent-to-use application with no evidence of use hardly supports the registration of applicant's mark. In addition, while applicant refers to "212 pending and registered marks that contain the term CLUTCH" (Brief at 21), applicant has not made these records of record and, we cannot give applicant's cryptic reference any weight. Moreover, applicant admits that the "majority of such marks appear to be related to the automotive field." Brief at 21. These records would not demonstrate that the mark CLUTCH is weak for the identified clothing in this case. Furthermore, evidence of a pending application "is incompetent as proof of anything other than the fact that such an application for registration was filed in the Patent Office." Zappia-Paradiso, S.A. v. Cojeva Inc., 144 USPQ 101, 102 n.4 (TTAB 1964).

marks in their entirety, we hold that the marks' similarities outweigh their dissimilarities. The arbitrary term CLUTCH dominates both marks. If "the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences." In re Denisi, 225 USPQ 624, 624 (TTAB 1985). The marks would be similar to the extent that they are both dominated by the word CLUTCH. The words would be pronounced the same to the extent that they have the same dominant word. The presence of the word "gear," to the extent it is noticed, would not cause prospective purchasers to distinguish the marks. Furthermore, CLUTCH GEAR and design and CLUTCH and design can have the same meaning, i.e., a motor vehicle clutch. Even if these purchasers understood applicant's mark to be a unitary term CLUTCH GEAR, this fact does not distinguish the marks. The meaning and commercial impression of the marks would still emphasize the reference to a motor vehicle clutch. Under these circumstances, we hold that the marks are similar.

The next factor we consider is whether applicant's and registrant's goods are related. We must consider these goods as they are identified in the application and registrations. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark

cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods").

Applicant argues that the "nature of the respective parties' goods are sufficiently dissimilar that no likelihood of confusion would result." Brief at 15. Applicant then cites several cases where there was a determination of no likelihood of confusion when various clothing items were involved. See, e.g., In re Shoe Works, 6 USPQ2d 1890 (TTAB 1988) (consent agreement); House of Worsted-Tex, Inc. v. Superba Cravats, Inc., 284 F.2d 528, 128 USPQ 119, 121 (CCPA 1960) (No likelihood of confusion between IVY LEAGUE MODEL and rectangle design for outer garments v. IVY HALL and IVY LOOM for neckties; "opposer has failed to establish an exclusive right to the term 'Ivy League' in the clothing field").

We have no disagreement with applicant's basic argument that differences in the specific articles of clothing in the identification of goods may be a significant factor in determining that there is no likelihood of confusion. However, applicant ignores the close relationship between specific articles of clothing in applicant's and registrant's identifications of goods. Applicant's goods are t-shirts, sweatshirts, sports shirts,

hats, and shorts. Registrant's goods include jackets, jogging pants, and sweatpants. While these goods are not necessarily identical, they are very closely related. For example, sweatshirts and sweatpants are complementary items. Purchasers seeking an outfit for exercise could clearly be in the market for sweatpants and sweatshirts. These items are worn together and their material composition could be the same. Furthermore, applicant's shorts could include jogging shorts, which would be similar to registrant's jogging pants. We decline the examining attorney's suggestion to read the term "suits" in registrant's identification of goods to include motorcycle suits because we do not believe that this is a fair reading of the term. However, the term "jackets" is a broad term that could clearly encompass more casual jackets worn while engaging in outdoor exercise such as jogging.

"In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources." McDonald's Corp. v.

McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001).

Registrant's casual clothing that would include jackets, jogging pants, and sweatpants are related to applicant's similar casual clothes such as sweatshirts, sports shirts and t-shirts. Therefore, we hold that applicant's goods and various goods in the cited registration are related. See, e.g. In re TSI Brands Inc., 67 USPQ2d 1657, 1659 (TTAB 2002) ("It is also common knowledge that athletic apparel, such as jerseys, sweaters, shorts, sweatshirts and sweatpants, is often purchased and worn as casual clothing or sportswear").

In addition, there are no restrictions on the channels of trade of the goods and we must assume that all the goods travel in the normal channels of trade for these goods. See Morton-Norwich Products, Inc. v. N. Siperstein, Inc., 222 USPQ 735, 736 (TTAB 1984) ("Since there is no limitation in applicant's identification of goods, we must presume that applicant's paints move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers"); In re Elbaum, 211 USPQ 639, 640 (TTAB 1981)("[W]here the goods in a cited registration are broadly described and there are no limitations in the identification of goods as to their

nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers"). At the very least, the channels of trade for t-shirts, sweatshirts, sports shirts and shorts and jackets, jogging pants, and sweatpants would be very similar, if not overlapping.⁴

Regarding the prospective purchasers, as indicated above, the prospective purchasers of t-shirts, sweatshirts, and shorts and jackets, and sweatpants would likely overlap. Furthermore, there is no evidence that the purchasers of these goods would be particularly careful or sophisticated and there is no per se rule that purchasers

⁴ Applicant argues that "no evidence of any established trade channels for the 'Japanese' goods has been shown, and to the contrary, the evidence suggests that the prior cited Registrant has yet to use such mark in any trade channels within U.S. commerce." Brief at 20. Applicant cannot attack a cited registration in an ex parte proceeding. In re Protection Controls, Inc., 185 USPQ 692, 693 (TTAB 1975) ("[E]ven were the cited registration based on foreign registration and use, it is entitled to all of the presumptions afforded a registration under Section 7(b) and, as such, constitutes a bar under Section 2(d) to the registration of a similar mark for like or similar goods"). As we indicated previously, we must consider that the registered mark is used in all normal channels of trade for the goods.

of casual shirts and sweatpants and jackets are anything other than ordinary purchasers exercising ordinary care in their purchases.

Applicant also points out that there is no evidence of the fame of the registrant's mark or evidence of actual confusion. In an ex parte case, registrant is not a party and the evidence of fame such as the nature and extent of advertising and sales, is not often available to the examining attorney. Also, applicant's assertion of a lack of actual confusion is not significant. Majestic Distilling, 65 USPQ2d at 1205 ("The lack of evidence of actual confusion carries little weight").

Therefore, we conclude that the marks CLUTCH GEAR and gear design and CLUTCH and Japanese characters design are similar. The goods such as sweatshirts and sweatpants are closely related. When we view all the other factors, we conclude that prospective purchasers are likely to be confused when they encounter these marks on closely related goods.

Disclaimer

The second issue in this appeal is the question of whether the applicant should be required to disclaim the term "gear." The examining attorney has submitted several dictionary definitions that show that the term "gear"

means, among other things, "clothing." The examining attorney has also submitted copies of numerous registrations that show that the term "gear" has been disclaimed in various registrations for clothing items.

With its appeal brief, applicant submitted numerous copies of registrations that show that the term "gear" has not been disclaimed in similar circumstances. The examining attorney has objected and we agree these registrations should have been submitted sooner. 37 CFR § 2.142(d). However, in its response dated December 12, 2003, applicant has submitted a copy of a registration (No. 2,739,717) that does show that the mark 3RD GEAR for "clothing, namely, T-shirts, sweatshirts, sport shirts and hats" registered without a disclaimer of the term "gear." Applicant also submitted printouts from Internet websites that show that there are parts referred to as a "Clutch Gear." See, e.g., www.duratrax.com (DTXC7124 Clutch Gear 14T Two Speed). See also APS Racing ("NTC3 Hard Coated 1st Clutch Gear, NTC3 Hard Coated 2nd Clutch Gear"); Hobby People ("HPI Clutch Gear Holder W/one-way/Savage 21... This is a replacement clutch gear holder with one way from HPI for the Savage 21"); Team Magic ("Hard Coated Alum. Light 24" Clutch Gear"); Hobbylinc.com ("This K Factory Hard Aluminum Clutch Gear Wrench is Designed for Kyosho Cars...

Fits all clutch gears used on Kyosho V-One-R Phantom"); and NH Power ("Clutch Gear").

Applicant argues that as "part of a unitary mark, even if the mark CLUTCH GEAR is applied to clothing, the term GEAR alone, is simply not required to be disclaimed."

Brief at 8. We agree with applicant's argument that the term "Clutch Gear" is a unitary term. The Federal Circuit has held that a disclaimer was appropriate when "no particular meaning in the words European Formula or the circular design links these detached features. Belvedere presents no evidence about the meaning of these features." Dena Corp. v. Belvedere International Inc., 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). Here, applicant has presented evidence that the term "Clutch Gear" has a meaning. Applicant's gear design reinforces the mechanical/automotive connotation or meaning of the term. Prospective purchasers who would notice the term "gear" used in association of a design of a gear and the word clutch are likely to view the mark as a unitary term that emphasizes the clutch and shifting gears in an automobile or other motor vehicle. We add that while we conclude that the expression CLUTCH GEAR is unitary, it does not overcome our holding that confusion is likely. As we indicated above, the term "Gear" is a subordinate term and used in a

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less noticeable manner by applicant. When purchasers would encounter the term, they would have already been well aware of the dominant term "Clutch" and the design of a gear. While these purchasers are likely to then see the term CLUTCH GEAR as unitary, this term would not be dissimilar to the registrant's mark.

Decision: The examining attorney's requirement for a disclaimer is reversed. The refusal to register applicant's mark under Section 2(d) is affirmed.